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**Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/576,992 05/24/00 ARCELLA

V 108910-00006

IM52/0928  
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EXAMINER

WARD, R

ART UNIT

PAPER NUMBER

1723

DATE MAILED: 09/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/576,992

Applicant(s)  
Arcella et al

Examiner  
Richard W. Ward

Art Unit  
1723



-- Th MAILING DATE of this communication appears on the cover sheet with th correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Jul 18, 2001

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-16 is/are pending in the applica

4a) Of the above, claim(s) 8-15 is/are withdrawn from considera

5) ☐ Claim(s) is/are allowed.

6) ☒ Claim(s) 1-7 and 16 is/are rejected.

7) ☐ Claim(s) is/are objected to.

8) ☐ Claims are subject to restriction and/or election requirem

## Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☒ All b) ☐ Some\* c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4,6

20) ☐ Other:

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## DETAILED ACTION

### *Election/Restriction*

1. Applicant's election of Group I, claims 1-7 and 16, and the species including a monomer of formula (II) where  $Y1=Y2=F$  and the comonomer of formula (I) where  $X1=X2=F$  and  $Z=OCF_3$ , in Paper No. 8 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 8-15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 8.

### *Priority*

3. Receipt is acknowledged of papers (including a verified translation of MI 99 A 001153) submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Information Disclosure Statement*

4. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be

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incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. See especially pages 3, 4, 8, and 13.

### ***Specification***

5. The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

The following order or arrangement is preferred in framing the specification and, except for the reference to "Microfiche Appendix" and the drawings, each of the lettered items should appear in upper case, without underlining or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) Title of the Invention.
- (b) Cross-References to Related Applications.
- (c) Statement Regarding Federally Sponsored Research or Development.
- (d) Reference to a "Microfiche Appendix" (see 37 CFR 1.96).
- (e) Background of the Invention.
  - 1. Field of the Invention.
  - 2. Description of the Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) Brief Summary of the Invention.
- (g) Brief Description of the Several Views of the Drawing(s).
- (h) Detailed Description of the Invention.
- (i) Claim or Claims (commencing on a separate sheet).
- (j) Abstract of the Disclosure (commencing on a separate sheet).
- (k) Drawings.
- (l) Sequence Listing (see 37 CFR 1.821-1.825).

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6. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: the term "porosity" is improperly used (pages 1, 6, claim 1, etc.), proper term is "pore size"; "(per)fluorinated" (page 1, claim 1, etc.), unclear word usage; "Europen" (page 1), "perlfluorinated" (page 2), "tetrafluoretilene" (page 4) -- misspellings.

7. A substitute specification including claims and abstract is required pursuant to 37 CFR 1.125(a) because of numerous grammatical and word usage errors, and because proper format (including headings) for a U.S. application is not used (see above).

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

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***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 3-7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 3 appears to be a product by process claim. It is submitted that one having ordinary skill in the art would not be enabled to make a porous membrane using the single step of polymerization as recited within the claim; instead, further steps are required, as is evidenced by pages 9-11, which detail a casting process.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-7 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative (especially claims 1-2) and indefinite (all claims), failing to conform with current U.S. practice. They appear to be a literal translation into English

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from a foreign document and are replete with grammatical and idiomatic errors. Examples of such errors are pointed out below.

The claims contain the unclear term (per)fluorinated. This term is unclear because it is unknown if applicant is attempting to claim "perfluorinated" polymers, or in the alternative, "fluorinated" polymers which are optionally "perfluorinated".

The use of the term "porosity" is unclear, because porosity is art recognized as being a measure of total pore volume of a membrane, not individual pore sizes, as the units 5-500 nm appear to reflect. }

Regarding claims 1, 5, 7, and 17, the use of exemplary claim language, i.e., "preferably" and "such as", renders the claims indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 16 provides for the use of porous membranes, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

### ***Claim Rejections - 35 USC § 101***

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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13. Claim 16 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

15. Claims 1, 3, 5, 7, and 16 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Banerjee (US 5,795,668). '668 discloses a membrane (and use of said membrane) made from a perfluorinated amorphous polymer mixture as specified within the claims. See especially column 5, lines 50-56 and column 7, lines 6-14.

***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:



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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flottmann et al (US 4,923,608) in view of Resnick et al (Reference AQ, IDS #4).

As to claims 1-2, '608 discloses a membrane made from polymer films (including fluoropolymer films -- see column 3, lines 8-9) having the specified pore size (see column 2, lines 32-39). '608 fails to recite the use of an amorphous perfluoropolymer. Resnick et al teaches amorphous TEFLON AF which is more easily processible than TEFLON (which is suggested in column 3, lines 8-9 of '608) and is cable of being vaporized by a laser -- see especially pages 414-418.

Concerning claims 3-7, '608 teaches the use of blends of any fluorinated dioxole compound (including TDD, see figure 22.5) with TFE (pages 398-401).

### ***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Colaianna et al (US 5,883,177) further suggests the use of TDD instead of PDD.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard W. Ward whose telephone number is (703)305-0536. The examiner can normally be reached on Monday-Friday from 7:00 AM to 3:30 PM.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Walker, can be reached on (703)308-0457. The fax phone number for the organization where this application or proceeding is assigned is (703)305-3602.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703)308-0661.

R.W.W.

September 22, 2001



**ANA FORTUNA**  
**PRIMARY EXAMINER**